

**REMARKS**

Claims 1, 18-26 are pending in this application; claims 2-17 are cancelled. Claim 1 has been amended to clarify the claimed invention. Claims 18-26 are added to further define the invention.

Claim 1 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Kayan (U.S. 6,537,289) over Miller (U.S. 6,709,442). Applicants traverse this rejection.

Claim 1 claims a delivery device that includes an elongated hollow member having a longitudinal axis, a plurality of fasteners sized to be contained within the hollow member serially with respect to one another along the longitudinal axis, a moving member configured to move between a first position and a second position along the longitudinal axis, the moving member having a sharpened distal end for piercing tissue, and an elongate member disposed substantially within the hollow member, the elongate member being positionable along the longitudinal axis between a first position, whereat the elongate member engages the proximal end of the distal-most one of the plurality of fasteners, and a second position whereat the elongate member does not engage the distal-most one of the plurality of fasteners, and wherein the moving member and the elongate member are movable with respect to one another within the hollow member.

Applicants submit that neither Kayan nor Miller nor the combination of Kayan with Miller teaches or suggests the claimed inventions. As the Examiner indicates, among other elements, Kayan does not disclose the claimed moving member having a sharpened distal end for piercing tissue. And this is for good reason. Kayan discloses a blood vessel clip applicator for applying a series of clips. The clips are configured to occlude a blood vessel; i.e., stop a blood vessel from bleeding. See Kayan col. 1, lines 10-14. This function is achieved by delivering a clip in a position about or surrounding the blood vessel and then permitting the clip to close. See, in particular, Figures 10 and 11 and column 4:48 through column 5:7 and column 9:45 through column 11:3.

A clip or clip applier, such as those described in Kayan, whose function is to stop bleeding generally will be designed to avoid cutting or piercing blood vessels. This is especially

the case where the clips and applier are used minimally invasively, where the user's ability to avoid damaging (piercing or cutting) tissue in the operating arena is limited due to limited visibility of the operating site. As a result, Kayan teaches that the clips should be designed to be atraumatic. See Kayan, Figures 18-27 and the description at column 4:58-60 (pins preferably have smooth atraumatic surfaces); column 9:50-51 (balls of clip serve to protect the blood vessel from trauma while the distal end of the clip is pushed over the blood vessel); column 17:2-7 (first and second leg mating surfaces of clip are smooth and atraumatic). Further, the distal working end of the Kayan delivery device is designed to be blunt. See Figures 4-16. In fact, Applicants' representative has searched Kayan and can not find any reference to a sharp surface or element at the distal or working end of the system described in Kayan. Kayan, at essence, *teaches away* from combination with Miller as adding a piercing element to Kayan would make the device unworkable for its purpose.

Miller, on the other hand, has a moving element for piercing tissue, however, Miller does not provide a mechanism for delivering a plurality of fasteners in series. Miller depicts delivering a single fastener down a tube using a plunger. See Figures 5A-5F. Miller further depicts delivering a first and then a second fastener down two separate tubes. See Figures 29-33. Finally, Miller depicts delivering a plurality of fasteners about a perimeter, each of the fasteners again delivered down a separate tube. See Figures 35-38. Miller does not suggest the need to deliver the fasteners in series, nor does it provide a means of doing so.

In short, for the above and additional reasons, one skilled in art would not be motivated or have a need to combine Kayan with Miller. As a result, Applicants submit that one skilled in the art would not do so and request the Examiner to withdraw the rejection.

With respect to new independent claims 24 and 26, neither Kayan nor Miller teach or suggest that the moving member (having the sharpened distal end) and elongate member are spaced from one another traversely to define a passageway within which the fasteners are disposed **and** are movable with respect to one another. Instead, Miller's moving member, indicated to be the plunger mechanism, pushes the fastener from behind, and Kayan simply has a moving member (without a sharpened distal end) that moves and does not have an elongate

Serial No. 10/015,631

member that moves with respect to the moving member. As such, for this and other reasons, Applicants submit that claims 24 and 26 and those claims that depend therefrom are patentable.

Claim 1 stands rejected under the doctrine of obviousness-type double patenting as being unpatentable over claim 47 of US Patent No. 6,572,626. Applicants submit herewith a terminal disclaimer to obviate the rejection.

Applicants have invented a novel and nonobvious device for delivering serially a plurality of fasteners. Applicants request the Examiner to consider the above and indicate the allowability of the claims.

Respectfully submitted,

/Brian S. Tomko/

Brian S. Tomko  
Registration No. 41,349

Johnson & Johnson  
One Johnson & Johnson Plaza  
New Brunswick, NJ 08933-7003  
(732) 524-1239  
Dated: July 5, 2007